UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,373	07/17/2003	Ai Satoyama	H-900-02	9718

24956 7590 03/22/2005

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER	
KIM, HONG CHONG	

ART UNIT	PAPER NUMBER
2186	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/620,373	SATOYAMA ET AL.	
	Examiner	Art Unit	
	Hong C Kim	2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-20* is/are rejected.

7)☒ Claim(s) *21-24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1. Claims 9-24 are presented for examination. This office action is in response to the amendment filed on 12/22/2004.

2. The examiner requests, in response to this Office action, any reference(s) known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the invention as defined by the independent and dependent claims. That is, any prior art (including any products for sale) similar to the claimed invention that could reasonably be used in a 102 or 103 rejection. This request does not require applicant to perform a search. This **request** is not intended to interfere with or go beyond that **required** under 37 C.F.R. 1.56 or 1.105.

The request may be fulfilled by asking the attorney(s) of record handling prosecution and the inventor(s)/assignee for references qualifying as prior art. A simple statement that the query has been made and no prior art found is sufficient to fulfill the request. Otherwise, the fee and certification requirements of 37 CFR section 1.97 are waived for those documents submitted in reply to this request. This waiver extends only to those documents within the scope of this request that are included in the application's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this request and any information disclosures beyond the scope of this are subject to the fee and certification requirements of 37 CFR section 1.97.

In the event prior art documentation is submitted, a discussion of relevant

passages, figs. etc. with respect to the claims is requested. The examiner is looking for specific references to 102/103 prior art that identify independent and dependent claim limitations. Since applicant is most knowledgeable of the present invention and submitted art, his/her discussion of the reference(s) with respect to the instant claims is essential. **A response to this inquiry is greatly appreciated.**

The examiner also requests, in response to this Office action, support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line number(s), in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

DOUBLE-PATENTING

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Although the applicant rep stated on 12/22/2004 that applicant submitted a Terminal Disclaimer to over come the double patenting rejection, the Examiner could not find the Terminal Disclaimer. The Examiner requests to resubmit the Terminal Disclaimer. Again claims 9-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,615,327. Claims of patent No. 6,615,327 contains every element of claims 9-24 of the instant application and as such anticipates claims 9-24 of the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitamura et al. (Kitamura) US Patent 6,499,056.

As to claim 9, Kitamura discloses the invention as claimed. Kitamura discloses in a computer system which has a first computer (Fig. 13 Ref. 1), a second computer (Fig. 13 Ref. 2) connected to said first computer via a communication line (Fig. 13 line between Refs. 22 and 12), a storage apparatus (Fig. 13 Ref. 2020) connected to said second computer via fixed length access interface (Fig. 13 Ref. 21) and storing data in a fixed-length block format used by said second computer, a method for processing data stored in said storage apparatus to said first computer comprising the steps of:

Requesting (col. 14 lines 34-40 & 50+, col. 8 lines 8-12 and col. 15 lines 11-14), from said first computer to said second computer via communication line, data stored in said storage apparatus in said fixed-length block format;

reading (col. 12 lines 15-16 and col. 14 lines 60+, retrieving data reads on this limitation), in response to said request data in said fixed- length block format from said storage apparatus via said fixed length access interface and transferring said read data to said first computer via communication line, by using said second computer;

converting (col. 14 lines 17-20 and Fig. 13 Ref. 2027), in said first computer, said transferred data in said fixed-length block format to data in variable-length block format; and

processing (Fig. 13 Ref. 13 and 2014) said converted data in said first computer.

As to claim 10, Kitamura discloses the invention as claimed the above. Kitamura further discloses making volume information for accessing data stored in said storage apparatus, in said first computer (col. 5 lines 7-8 and Fig. 3).

As to claim 11, Kitamura discloses the invention as claimed the above. Kitamura further discloses said step for making said volume information comprising a step for storing said volume information (col. 5 lines 7-45 reads out the volume label to the host reads on this limitation) in a predetermined region formed in a main memory (col. 3 lines 27-28) of said first computer.

As to claim 12, Kitamura discloses the invention as claimed the above. Kitamura further discloses said volume information includes information of a starting position and an ending position of data in said fixed-length block format in said storage apparatus (Fig. 3 Ref. D).

As to claim 13, Kitamura discloses the invention as claimed. Kitamura discloses a computer in a variable length block format comprising (Fig. 13 Ref. 2010):

a communication unit (Fig. 13 Refs. 22 and 12) to communicate through a communication line with another computer which is connected to a storage apparatus (Fig. 13 Ref. 2020),

a processor (col. 3 lines 27-28) and,

a memory (col. 3 lines 27-28)

wherein said processor send a request (col. 14 lines 34-40) through said communication unit to said another computer to read data stored in said storage apparatus in fixed-length block format (Fig. 13 Ref. 2020), receives said read data from said another computer through said communication unit, and

converts (col. 14 lines 17-20 and Fig. 13 Ref. 2027) said data to data in variable-length block format, and processes (Fig. 13 Ref. 13 and 2014) said converted data.

As to claim 14, Kitamura discloses the invention as claimed the above. Kitamura further discloses make volume information (col. 5 lines 7-8 and Fig. 3) for accessing data stored in said storage apparatus.

As to claim 15, Kitamura discloses the invention as claimed the above. Kitamura further discloses said processor stores said volume information (col. 5 lines 7-45 reads out the volume label to the host reads on this limitation) in a predetermined region formed in a main memory of said first computer (col. 3 lines 27-28).

As to claim 16, Kitamura discloses the invention as claimed the above. Kitamura further discloses said volume information includes information (Fig. 3 Ref. D) of a starting position and an ending position of data in said fixed-length block format in said storage apparatus.

As to claim 17, Kitamura discloses the invention as claimed. Kitamura discloses a system (Fig. 13) comprising:

a first computer (Fig. 13 Ref. 1),

a second computer (Fig. 13 Ref. 2) connected to said first computer through a communication line (Fig. 13 a line between Refs. 22 and 12),

a storage apparatus (Fig. 13 Ref. 2020) storing data in a fixed-length block format connected to said second computer via a fixed length access interface (Fig. 13 Ref. 21),

wherein said first computer requests (col. 14 lines 34-40) said second computer to send data stored in said storage apparatus via said communication line,

wherein said second computer reads (col. 14 lines 34+ and col. 12 lines 15-16) said data stored in said storage apparatus via said fixed length access interface and transfers said data to said first computer via said communication line based on said request, and

wherein said first computer receives said transferred data, converts said received data to a variable-length block format (col. 14 lines 17-20 and Fig. 13 Ref. 2027), and processes (Fig. 13 Ref. 13 and 2014) said converted data.

As to claim 18, Kitamura discloses the invention as claimed the above. Kitamura further discloses said processor makes volume information (col. 5 lines 7-8 and Fig. 3) for accessing data stored in said storage apparatus.

As to claim 19, Kitamura discloses the invention as claimed the above. Kitamura further discloses said processor stores said volume information (col. 5 lines 7-45 reads out the volume label to the host reads on this limitation) in a predetermined region formed in a main memory of said first computer (col. 3 lines 27-28).

As to claim 20, Kitamura discloses the invention as claimed the above. Kitamura further discloses said volume information which includes information (Fig. 3 Ref. D) of a starting position and an ending position of data is said fixed-length block format in said storage apparatus.

Allowable Subject Matter

6. Claims 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

7. Applicant's arguments filed on 12/22/04 have been fully considered but they are not deemed to be persuasive.

Applicant's remarks that the references not teaching a first computer and a second computer are connected via a communication line is not considered persuasive.

Kitamura discloses a first computer (Fig. 13 Ref. 1) and a second computer (Fig. 13 Ref. 2) are connected via a communication line (Fig. 13 line between Refs. 22 and 12).

Applicant's remarks that the references not teaching reading by using the second computer is not considered persuasive.

Kitamura discloses reading (col. 12 lines 15-16 and col. 14 lines 60+, retrieving data reads on this limitation) by using the second computer reading by using the second computer.

Applicant's remarks that the references not teaching a computer in a variable length block format is not considered persuasive.

Kitamura discloses a computer in a variable length block format (Fig. 13 Ref. 1).

Therefore broadly written claims are disclosed by the references cited.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

9. **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. When responding to the office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. ' 1.111(c).

11. When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hong C Kim whose telephone number is 703-305-3835. The examiner can normally be reached on M-F 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt M Kim can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to TC-2100:
(703) 872-9306

H Kim
Primary Patent Examiner
March 20, 2005